

REMARKS

Applicant thanks the Examiner for granting a telephonic interview on the afternoon of February 22, 2005. The subject matter of Applicant's independent claims was discussed in light of the Minowa '408 and Onoda references. Agreement was not reached regarding the patentability of the subject matter of Applicant's independent claims. However, the foregoing claim amendments reflect subject matter discussed during the interview and suggested by the Examiner as more descriptive of features illustrated in Applicant's FIGs. 3, 5, 7, and 9.

The outstanding non-final Office Action mailed November 4, 2004 has been carefully considered. In response thereto, Applicant submits herewith the foregoing amendments and following remarks. Claims 1, 3 – 9, 12 – 17, 20, 21, 26, 27 – 32, 34 – 37, 40, 42 – 44, 48, 52 – 55, 59 – 61, 64, 66 – 70, and 72 – 75 are amended. Claims 1 – 77 are now pending in the present application. The subject matter of amended claims 1, 3 – 9, 12 – 17, 20, 21, 26, 27 – 32, 34 – 37, 40, 42 – 44, 48, 52 – 55, 59 – 61, 64, 66 – 70, and 72 – 75 can be found in at least FIGs. 3 – 5, 7, 9, and 10 and the related detailed description. Thus, Applicant submits no new matter has been added to the application.

In view of the foregoing amendments and the following remarks, reconsideration and allowance of the present application and claims 1 – 77 are respectfully requested.

I. Claim Rejections Under 35 U.S.C. §102 – Claims 1, 2, 4 – 8, 12 – 14, 16 – 26, 28 – 32, 34, 35, 37, 40 – 43, 59 – 63, and 75

A. Statement of the Rejections

Claims 1, 2, 4 – 8, 12 – 14, 16 – 26, 28 – 32, 34, 35, and 37 are rejected under 35 U.S.C. 102(a) as allegedly anticipated by Minowa Japanese Publication No. 2000-209408 (*Minowa '408*).

Claims 40 – 43, 59 – 63, and 75 are rejected under 35 U.S.C. 102(e) as allegedly anticipated by Onoda U.S. Patent 6,433,941 (*Onoda*).

B. Discussion of the Rejections

Applicant's independent claims 1, 16, 20, 26, and 37 recite a combination of elements, features, or method steps that are not disclosed, taught, or suggested by *Minowa '408*.

Applicant's claims 40 – 43, 59 – 63, and 75 recite elements, features, or method steps that are not disclosed, taught, or suggested by *Onoda*.

A proper rejection of a claim under 35 U.S.C. §102 requires that a single prior-art reference disclose each element, feature, or step of the claim. See e.g., *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 7 USPQ2d 1129. (Fed. Cir. 1988.)

1. Claims 1, 2, 4 – 8, and 12 – 14

Applicant's independent assembly claim 1 comprises a housing, a member forming a channel, and a flap. Applicant's claimed member protrudes from the housing and comprises a first side that is substantially parallel to, and opposed from, the source-contact surface of the housing. The member has a second side substantially orthogonal to the first side. In addition, the claimed member extends to an exterior surface of the housing. The combination of these features is not disclosed, taught, or suggested in *Minowa '408*.

In contrast with Applicant's claimed assembly, *Minowa '408* (FIGs. 4 and 6) shows a housing (11) and a flap (14), the opposing inner surfaces of which, form an aperture extending from an edge of the housing (14b) to an opposing edge (14c) close to the edge of a platen (12) for scanning a source inserted in the aperture. FIG. 4 of *Minowa '408* apparently shows that flap (14) is configured with a surface that supports the source when it is arranged against the platen (12) of the scanner. FIGs. 7 and 8 of *Minowa '408* apparently reveal a ledge (44) that extends from the flap (14) and is received in a slot (42) within housing (11) when the flap (14) is arranged in proximity to the housing (11). Absent from *Minowa '408* is any teaching of Applicant's claimed member, which protrudes from the housing, extends to an exterior surface of the housing, and comprises a first side substantially parallel to, and opposed from, the source-contact surface of the housing and a second side substantially orthogonal to the first.

Applicant's claimed assembly comprises a member forming a channel in addition to a flap and a housing. *Minowa '408* apparently discloses a flap with a ledge 44 that is received by a recess 42 in housing 11. Thus, Applicant's assembly comprises structure and features that are not found in *Minowa '408*. For at least the reason that *Minowa '408*

fails to disclose, teach, or suggest Applicant's claimed member, claim 1 is not anticipated by *Minowa '408*. Thus, Applicant's claimed assembly is allowable over *Minowa '408*.

Because independent claim 1 is allowable, its respective dependent claims 2, 4 - 8, and 12 - 14 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or steps of independent claim 1. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Accordingly, Applicant respectfully requests that the rejection of claims 1, 2, 4 - 8, and 12 - 14 be withdrawn.

2. Claims 16 - 19

Applicant's claim 16, as amended, recites a space-saving scanner assembly comprising "means for forming an aperture configured to closely receive a leading edge of a source, such that the source can be spatially arranged with the optical scanning means without adjusting the aperture, *the source being supported along a horizontal edge different from the leading edge of said source along a channel means in the aperture.*" At least the emphasized feature of claim 16 is not found in *Minowa '408*.

In contrast with Applicant's claimed scanner assembly, FIGs. 4 and 6 of *Minowa '408* appear to show an aperture defined by a flap and a housing arranged to receive and support a leading edge of a source when the source is aligned with a means for optically scanning. An aperture that receives and supports a source along a leading edge does not disclose, teach, or suggest "the source being supported along a horizontal edge different from the leading edge of said source." Furthermore, an aperture defined by a flap and a housing does not disclose, teach, or suggest "a channel means in the aperture." Thus, the cited art of record fails to disclose, teach, or suggest at least the emphasized element of independent claim 16. Accordingly, for at least this reason, *Minowa '408* fails to anticipate Applicant's claim 16.

Because independent claim 16 is allowable, its respective dependent claims 17 - 19 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 16. *See In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection of claims 16 - 19 be withdrawn.

3. Claims 20 – 25

Applicant's claim 20 recites a method for saving space on a desktop comprising: "coupling a flap to the source-contact surface, *the flap having a slot extending to an edge of the flap* and source-backing surface substantially parallel to the source-contact surface of the housing, *wherein the source-contact surface, the source-backing surface, and the member form an aperture for horizontally receiving a source to be scanned.*" At least the emphasized features of claim 20 are not disclosed, taught, or suggested in *Minowa '408*.

In contrast with Applicant's claimed scanner assembly, FIGs. 4 and 6 of *Minowa '408* appear to show an aperture formed by the source-contact surface of the housing and a flap. FIG. 4 appears to show that the source rests on a ledge (14c) extending from the flap.

Absent from *Minowa '408* is any suggestion of a flap with a slot. Further absent from *Minowa '408* is a member that together with a flap and a housing forms an aperture for horizontally receiving a source to be scanned. Accordingly, for at least these two reasons, *Minowa '408* cannot anticipate Applicant's claimed method for saving space on a desktop. Thus, claim 20 is allowable over *Minowa '408*.

Because independent claim 20 is allowable, its respective dependent claims 21 – 25 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 20. *See In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection of claims 20 – 25 be withdrawn.

4. Claims 26, 28 – 32 and 34 - 36

Applicant's independent claim 26 comprises, a housing with a substantially vertical source contact surface, a member forming a channel, and a flap. Applicant's claim 26 comprises the feature that the source-contact surface, the source-backing surface, and the member form an aperture for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing. As shown above, *Minowa '408* fails to disclose, teach, or suggest a combination of a housing, a member and a flap forming an aperture. Furthermore, *Minowa '408* fails to disclose, teach, or suggest an aperture for horizontally receiving a source to be scanned

without necessitating relative movement between the flap and the housing.”

Accordingly, for at least these two reasons, *Minowa* ‘408 cannot anticipate Applicant’s claim 26. Thus, claim 26 is allowable over *Minowa* ‘408.

Because independent claim 26 is allowable, its respective dependent claims 28 – 32 and 34 – 36 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 26. *See In re Fine, supra*. Accordingly, Applicant respectfully requests that the rejection of claims 26, 28 – 32 and 34 – 36 be withdrawn.

5. Claim 37

Applicant’s claim 37, as amended, recites a method for arranging a source in a scanner comprising: “*horizontally inserting a leading edge of the source into an aperture formed by a member that protrudes from a housing such that a second edge of the source, different from the leading edge, is supported by a base of said member, said base having a width that varies along the length of the member.*” At least the emphasized features of claim 37 are not found in *Minowa* ‘408.

In contrast with Applicant’s claimed scanner assembly, FIGs. 4 and 6 of *Minowa* ‘408 appear to show an aperture formed by the source-contact surface of the housing and a flap. FIG. 4 appears to show that the source rests on a ledge (14c) extending from the flap. Thus, *Minowa* ‘408 appears to show an aperture configured to receive and support a leading edge of a source when the source is aligned with a means for optically scanning.

An opening formed along the top surface of a housing is not an aperture that can horizontally receive a leading edge of a source. A ledge which supports the leading edge of a source when the source is aligned with a sensor does not disclose, teach, or suggest that a second edge of the source different from the leading edge is supported by a base of said member. Moreover, a non-varying ledge does not disclose, teach, or suggest a base having a width that varies along the length of the member. Accordingly, for at least these three reasons, *Minowa* ‘408 cannot anticipate Applicant’s claim 37. Thus, claim 37 is allowable over *Minowa* ‘408 and the rejection should be withdrawn.

6. Claims 40 – 43, 59 - 63, and 75

Applicant's independent claims 40, 59, and 75, as amended, recite at least one limitation that is not disclosed, taught, or suggested by *Onoda*. Consequently, these claims are not anticipated by *Onoda*.

For example, independent claim 40, directed to a scanner assembly, comprises "a support member interposed between said housing and said flap and extending to a front panel of the housing, wherein the source-contact surface, the source-backing surface, and said support member form an aperture for horizontally receiving a source to be scanned without necessitating relative movement between the flap and the housing." This feature is not disclosed, taught, or suggested by *Onoda*. Accordingly, claims 40 – 43 are not anticipated by *Onoda* and the rejection of these claims should be withdrawn.

Independent claim 59 is directed to a method for saving space on a desktop and comprises a "support member protruding from the housing, the support member extending to the exterior of the housing." This feature is not disclosed, taught, or suggested by *Onoda*. Accordingly, claims 59 – 63 are not anticipated by *Onoda* and the rejection of these claims should be withdrawn.

Independent claim 75 is directed to a method for saving space on a desktop and comprises "horizontally inserting a leading edge of the source into an aperture formed by a support member interposed between a platen and a flap such that a surface of the source having information thereon that is desired to be imaged by the scanner is adjacent to a sensor arranged in a substantially vertical plane." This limitation is not disclosed, taught, or suggested by *Onoda*. Accordingly, claim 75 is not anticipated by *Onoda* and the rejection of this claim should be withdrawn.

II. Claim Rejections under 35 U.S.C. §103 - Claims 3, 9, 10, 11, 15, 27, 33, 36, 38, 39, and 44 – 77

A. Statement of the Rejections

The Office Action indicates that claims 10, 11, and 33 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Minowa '408* in view of *Minowa et al.* (U.S. Patent No. 6,408,161, hereafter *Minowa '161*.)

The Office Action indicates that claims 3, 9, 15, 27, and 36 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Minowa '408* in view of *Minowa* (Japanese Publication No. 2001-053918, hereafter *Minowa '918*.)

The Office Action indicates that claims 38 and 39 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Minowa '408*.

The Office Action indicates that claims 44, 46 – 48, 51, 55 – 58, 64, 66 – 68, 70, 73, 74, 76, and 77 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Onoda* in view of *Minowa '408*.

The Office Action indicates that claims 45 and 65 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Onoda* in view of *Minowa '408* and *Minowa '918*.

The Office Action indicates that claims 49 and 50 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Onoda* in view of *Minowa '161*.

The Office Action indicates that claims 52, 53, 69, and 72 presently stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Onoda* in view of *Minowa '408* and U.S. Patent 6,233,064 to *Griffin*.

The Office Action indicates that claim 54 presently stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Onoda*.

The Office Action indicates that claim 71 presently stands rejected under 35 U.S.C. §103(a) as allegedly being unpatentable over *Onoda* in view of *Minowa '408*, further in view of *Minowa '161*.

B. Discussion of the Rejections

Applicant's independent claims 1, 26, 37, 40, 55, 59, 64, and 75 recite structure/limitations that are not disclosed, taught, or suggested by the proposed combinations of *Onoda*, *Griffin*, *Minowa '408*, *Minowa '918*, and *Minowa '161*.

To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the specific combination that was made by the applicant. *In re Raynes*, 7 F.3d 1037, 1039, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992). As stated in MPEP 2143 - Basic Requirements of a *Prima Facie* Case of Obviousness,

[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant's independent claims 1, 26, 37, 40, 55, 59, 64, and 75 recite claim limitations that are not disclosed, taught, or suggested by the cited references. Accordingly, the proposed combinations fail to establish a *prima facie* case for obviousness for failure to teach or suggest all the claim limitations.

1. Claims 10, 11, and 33

Concerning Applicant's claims 10, 11, and 33, Applicant respectfully submits that *Minowa '161* fails to remedy the failure of *Minowa '408* to disclose, teach, or suggest each element in claims 1 and 26, from which claims 10, 11, and 33 depend. Thus, even the proposed combination of *Minowa '408* in view of *Minowa '161* fails to disclose, teach, or suggest at least the elements/limitations emphasized above. Consequently, claims 10, 11, and 33 are allowable and the rejection of claims 10, 11, and 33 should be withdrawn.

2. Claims 3, 9, 15, 27, and 36

Regarding Applicant's claims 3, 9, 15, 27, and 36, Applicant respectfully submits that *Minowa '918* fails to remedy the failure of *Minowa '408* to disclose, teach, or suggest each element in claims 1 and 26, from which claims 3, 9, 15, 27, and 36 depend. Thus, even the proposed combination of *Minowa '408* in view of *Minowa '918* fails to disclose, teach, or suggest at least the elements emphasized above. Consequently, claims 3, 9, 15, 27, and 36 are allowable and the rejection of claims 3, 9, 15, 27, and 36 should be withdrawn.

3. Claims 38 and 39

Regarding Applicant's claims 38 and 39, Applicant respectfully submits that *Minowa '408* fails to disclose, teach, or suggest each element in claim 37. Because independent claim 37 is allowable over *Minowa '408*, as shown above, its respective dependent claims 38 and 39 are also allowable, as a matter of law, since these dependent claims contain all elements, features, or limitations of independent claim 37. *See In re Fine, supra*. Accordingly, the rejection of claims 38 and 39 should also be withdrawn.

4. Claims 44, 46 – 48, 51, 55 – 58, 64, 66 – 68, 70, 73, 74, 76, and 77

Regarding Applicant's claims 44, 46 – 48, 51, 55 – 58, 64, 66 – 68, 70, 73, 74, 76, and 77, Applicant respectfully submits that *Minowa '408* fails to remedy the failure of *Onoda* to disclose, teach, or suggest each element in amended independent claims 40, 55, 59, 64, and 75, from which claims 44, 46 – 48, 51, 56 – 58, 66 – 68, 70, 73, 74, 76, and 77 depend. Consequently, the proposed combination fails to establish a *prima facie* case of obviousness against claims 44, 46 – 48, 51, 55 – 58, 64, 66 – 68, 70, 73, 74, 76, and 77. Accordingly, these claims are allowable and the rejection of claims 44, 46 – 48, 51, 55 – 58, 64, 66 – 68, 70, 73, 74, 76, and 77 should be withdrawn.

5. Claims 45 and 65

Regarding Applicant's claims 45 and 65, Applicant respectfully submits that *Minowa '408* and *Minowa '918* fail to remedy the failure of *Onoda* to disclose, teach, or suggest each element in amended independent claims 40 and 64, from which claims 45 and 65 depend. Consequently, the proposed combination fails to establish a *prima facie* case of obviousness against claims 45 and 65. Accordingly, these claims are allowable and the rejection of claims 45 and 65 should be withdrawn.

6. Claims 49 and 50

Regarding Applicant's claims 49 and 50, Applicant respectfully submits that *Minowa '161* fails to remedy the failure of *Onoda* to disclose, teach, or suggest each element in amended independent claim 40, from which claims 49 and 50 depend. Consequently, the proposed combination fails to establish a *prima facie* case of

obviousness against claims 49 and 50. Accordingly, these claims are allowable and the rejection of claims 49 and 50 should be withdrawn.

7. Claims 52, 53, 69 and 72

Regarding Applicant's claims 52, 53, 69, and 72, Applicant respectfully submits that *Minowa '408* and *Griffin* fail to remedy the failure of *Onoda* to disclose, teach, or suggest each element in amended independent claims 40 and 64, from which claims 52, 53, 69 and 72 depend. Consequently, the proposed combination fails to establish a *prima facie* case of obviousness against claims 52, 53, 69, and 72. Accordingly, these claims are allowable and the rejection of claims 52, 53, 69, and 72 should be withdrawn.

8. Claim 54

Regarding Applicant's claim 54, Applicant respectfully submits that *Onoda* fails to disclose, teach, or suggest each element in amended independent claim 40, from which claim 54 depends. Consequently, *Onoda* fails to establish a *prima facie* case of obviousness against claim 54. Accordingly, claim 54 is allowable and the rejection of claim 54 should be withdrawn.

9. Claim 71

Regarding Applicant's claim 71, Applicant respectfully submits that the proposed combination of *Onoda* in view of *Minowa '408* in further view of *Minowa '161* fails to disclose, teach, or suggest each element in amended independent claim 64, from which claim 71 depends. Consequently, the proposed combination fails to establish a *prima facie* case of obviousness against claim 71. Accordingly, claim 71 is allowable and the rejection of claim 71 should be withdrawn.

CONCLUSION

In light of the foregoing amendments and for at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1 – 77 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,

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& RISLEY, L.L.P.**

A handwritten signature in cursive script, appearing to read "Robert A. Blaha", written in black ink.

Robert A. Blaha,
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